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10/789,721	02/27/2004	Tilo Reinhardt	11884/411001	9633

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KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004		

EXAMINER	
FABER, DAVID	

ART UNIT	PAPER NUMBER
2178	

MAIL DATE	DELIVERY MODE
05/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/789,721

Applicant(s)

REINHARDT ET AL.

Examiner

David Faber

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 9, 10, 30, 31 and 45-84 is/are pending in the application.
- 4a) Of the above claim(s) 45-84 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9, 10, 30, 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This office action is in response to the amendment filed on 2 April 2007.
2. Claims 1-8, 11-29, and 32-44 have been cancelled by the Applicant.
3. Claims 9, 10, 30, and 31 have been amended.
4. Claims 45-84 have been added.
5. The rejection of Claims 3, 11-12, 24, and 36 under 35 U.S.C. 112, first paragraph has been withdrawn necessitated by the amendment. The rejection of Claims 3, 10, 11, 15, 24, 31, 36, and 43 under 35 U.S.C. 112, second paragraph has been withdrawn necessitated by the amendment. The rejection of Claims 1-7, 13-14, 17, 20-21, 22-28, 33-34, 38, and 41-44 under 35 U.S.C. 102(e) as being anticipated by Collie et al (US Paten 7,017,112, filed 2/28/2003) has been withdrawn necessitated by the amendment. The rejection of Claims 12 and 32 under 35 U.S.C. 103(a) as being unpatentable over Collie et al has been withdrawn necessitated by the amendment. The rejection of Claims 8, 16, 19, 29, 35, and 40 under 35 U.S.C. 103(a) as being unpatentable over Collie et al in further in view of Young ("Microsoft Office System Inside Out: 2003 Edition", publish 10/23/2003, pp 1-15) has been withdrawn necessitated by the amendment. The rejection of Claims 11 and 36 under 35 U.S.C. 103(a) as being unpatentable over Collie et al in further in view of Khanuja et al (US PGPub 20040102683, filed 4/15/2003, provisional filed on 4/16/2002) has been withdrawn necessitated by the amendment. The rejection of Claims 15 and 37 under 35 U.S.C. 103(a) as being unpatentable over Collie et al in further in view of Young in further in view of Khanuja et al has been withdrawn necessitated by the amendment.

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The rejection of Claims 18 and 39 under 35 U.S.C. 103(a) as being unpatentable over Collie et al in further in view of Korpela ("Tab Separated Values (TSV): a format for tabular data exchange", published as of 10/20/2001, pp 1-6) has been withdrawn necessitated by the amendment.

6. Claims 9, 10, 30, 31, and 45-84 are pending. Claims 9, 31, 45, 62, 80, 81, and 83 are independent claims.

#### ***Election/Restrictions***

7. Newly submitted claims 45-84 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 45-84 are direct to a system for extracting data from a document and associating metadata with the extracted data by storing both into a new file as disclosed in class 715, subclass 530. The original presented invention involves format transformation from a first format of a document into a user-modifiable document format as disclosed in class 715, subclass 523.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 45-84 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Specification***

8. The disclosure is objected to because of the following informalities:
9. The amendment filed 2 April 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: a database stored in a memory. The original disclosure of the specification and the drawings did not mention the disclosure of a database.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Objections***

10. Claim 30 objected to because of the following informalities:
- Claim 30 recites "fir st" with the limitation. The Examiner believes this a typographical error and should be viewed as "first" as done so throughout this Office Action.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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12. Claims 30-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. Claim 30 recites the limitation "converting the data from the first format to the user-modifiable document format includes arranging the data as a plurality of data elements, the arrangement providing a document context;" in lines 17-19. The Examiner is unsure if the converting the data is a new step or depending on the "converting a data..." step in lines 5-6 of claim 30. Thus, there is insufficient antecedent basis for this limitation in the claim.

14. Claim 30 recites the limitation "converting the data from the first format to the second format includes arranging the data as the plurality of data elements, the arrangement providing the document context;" in lines 26-28. The Examiner is unsure if the converting the data is a new step or depending on the "converting the data..." step in lines 21-22 of claim 30. Thus, there is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 101***

15. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

16. Claims 9-10 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**For your reference, below is a section from MPEP 2105 :**

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(a) Functional Descriptive Material: "Data Structures" Representing Descriptive Material Per Se or Computer Programs Representing Computer Listings Per Se

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.

Computer programs are often recited as part of a claim. Office personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory.

Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material. When a computer program is claimed in a process where the computer is executing the computer program's instructions, Office personnel should treat the claim as a process claim. See paragraph IV.B.2(b), below. When a computer program is recited in conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim.

17. Claims 9-10 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims appear to be claiming "software systems" i.e. systems without hardware indication, which is a computer program per se. Since the claims disclose computer program per se that is not embodied on a computer

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readable medium, they appear non-statutory.

***Allowable Subject Matter***

18. Claims 9-10, and 30-31 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

***Conclusion***

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



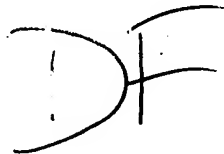
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Faber whose telephone number is 571-272-2751. The examiner can normally be reached on M-F from 8am to 430pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Faber  
Patent Examiner  
AU 2178



STEPHEN HONG  
SUPERVISORY PATENT EXAMINER